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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/676,370

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Kevin Maus

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02/03/2011

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EXAMINER

JOHNSON, GREGORY L

ART UNIT

PAPER NUMBER

3691

NOTIFICATION DATE

DELIVERY MODE

02/03/2011

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

Chgpatent@leydig.com

Office Action Summary	Application No. 10/676,370	Applicant(s) MAUS, KEVIN	
	Examiner GREGORY JOHNSON	Art Unit 3691	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 February 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 70,72-75,77 and 79-84 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 70,72-75,77 and 79-84 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--------------------------------------------------------------------------------------|-------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Request for Continued Examination under 37 CFR 1.1141

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on November 24, 2010 has been entered.

Status of Claims

2. Claims 1-69 are canceled. Claims 70, 73, 77 and 79-84 are amended. Claims 72 and 74-75 are as previously presented. Claims 70, 72-75, 77 and 79-84 are pending.

Response to Arguments

3. Applicant's arguments filed November 24, 2010 have been fully considered but they are not persuasive. Applicant argues:

- (a) [pg. 6, last ¶] ... the McLeod method does not contemplate any computer-implemented interaction between an insurance producer and a broker, much less a computer-implemented step relating to a broker licensed in a jurisdiction accepting a submission for a surplus lines insurance policy from an insurance producer that is not licensed the jurisdiction as recited in amended claim 70;

- (b) [pg. 7, first ¶] In the case where a broker does not have the proper surplus lines license, the McLeod method prohibits the access of the unlicensed broker to the surplus lines insurers through the website. Instead, the unlicensed broker must find a broker that is so licensed and is also a registered user of the website and must then establish an intermediary relationship between the unlicensed broker and the licensed broker;
- (c) [pg. 7, first ¶] ... McLeod fails to teach or suggest a computer-implemented method including steps of: accepting a submission from an insurance provider that is not licensed in the jurisdiction to broker surplus lines insurance policies of the type specified by the submission and, in response, identifying, by the server, at least one broker licensed in the jurisdiction that accepts submissions of the type transmitted by the insurance producer by searching broker data in a provided database that contains information sufficient to identify a plurality of brokers who are licensed in the jurisdiction to place surplus lines insurance policies of the type specified by the submission; and
- (d) [pg. 7, second ¶] ... the McLeod method teaches away from the method of amended claim 70 by emphasizing that the unlicensed broker is not allowed access through its website to the surplus lines insurers. Under such circumstances, the McLeod method requires the unlicensed broker to refer the request to a broker that is properly licensed and to have the licensed broker interact with the website to obtain a quotation.

In response to **(a) – (d)**, the McLeod method states the following (see highlighted section on page 2):

Agents will need to hold surplus lines licenses to access surplus lines insurers through iwix.net. An agent without such a license can have his or her submissions referred through surplus lines-licensed intermediaries registered with the site.

There is no mention of a broker/agent requirement of having a “proper surplus lines license”. The requirement is simply that a broker/agent possesses a surplus line license (as interpreted, being licensed to broker surplus line transactions in at least one state). As disclosed by the newly added reference, Fletcher discloses that surplus lines licenses are issued on a state-by-state basis. Therefore, a broker/agent possessing a surplus lines license for a first state (i.e. licensed) can have access to iwix.net; even though the same broker/agent is unlicensed in the remaining states. For example, a broker/agent possessing only a surplus lines license for the state of Florida, can access iwix.net and submit specialty risks for the state of Georgia (where the broker/agent is unlicensed).

In addition, Fletcher discloses that it is common among surplus line brokers to conduct business which involves the selling multistate insurance coverage. In conducting this type of business, the surplus lines broker faces a tax issue (i.e. paying premiums taxes). Fletcher further discloses that in the admitted market, premium taxes are paid by the licensed companies, directly to the state, on the amount of premium the company writes in that state. In the surplus lines market, premium tax payments are the unique and the sole responsibility of the broker who allocates and remits them to the

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state authorities. However, in some cases, a nonresident surplus lines broker cannot pay taxes to the states where portions of the multistate surplus lines risk lie, because the broker does not have, and cannot obtain, a non-resident surplus lines license (key points of the article on highlighted on pages 1 and 2).

The Examiner maintains that the combination of McLeod, Fletcher and Ghosh teach the limitations as recited in claim 70.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

6. **Claims 70, 72 and 80** are rejected under 35 U.S.C. 103(a) as being unpatentable over Douglas McLeod, "Web site connects insurers, agents", (hereinafter "McLeod"), in view of Meg Fletcher, "Opportunities expanding for surplus lines insurers" (hereinafter "Fletcher") and Ghosh et al., Pub. No. 2001/0032094 (hereinafter "Ghosh").

As to claim 70, McLeod discloses a computer-implemented method comprising:

- accepting, at a server, a submission of applicant insurance data for placement of a surplus lines (e.g. specialty risks) insurance policy transmitted by an insurance producer operating in a jurisdiction (pg.2; which discusses that agents can access the Internet Wholesale Insurance Exchanger (iwix.net) and submit specialty risks for quotations by participating insurers);
- notifying at least one identified broker about the submission (pg.2; which discusses the system e-mailing an insurer with a link to the site for viewing the (specialty risk) submission);
- permitting at least one identified broker access, through the server, to the submission (pg.2; which discusses insurers registering on the iwix.net site; and the system e-mailing an insurer with a link to the site for viewing the (specialty risk) submission);
- receiving, at the server, an acceptance of the submission for the insurance policy from one identified broker (pg.2; which discusses the system will e-mail the insurers a link to the site for viewing the submission and the system will deliver quotes to the agent);
(as interpreted, delivery of quotes to the agent implicitly teaches the acceptance of the submission by an insurer);
- generating a quotation, by the server, for the insurance policy in the submission (pg.2; which discusses the system will e-mail the insurers a

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link to the site for viewing the submission and the system will deliver quotes to the agent); and

- sending, by the server, the quotation to the insurance producer (pg.2; which discusses the system will e-mail the insurers a link to the site for viewing the submission and the system will deliver quotes to the agent).

McLeod teaches that agents will need to hold surplus lines licenses to access surplus lines insurers through iwix.net. (pg.2). However, McLeod does not explicitly teach the following element:

- [an insurance producer...] not being licensed in the jurisdiction to broker insurance policies of the type specified by the submission.

However, Fletcher discloses that it is common among surplus line brokers to conduct business which involves the selling multistate insurance coverage. In conducting this type of business, the surplus lines broker faces a tax issue (i.e. paying premiums taxes). Fletcher further discloses that in the admitted market, premium taxes are paid by the licensed companies, directly to the state, on the amount of premium the company writes in that state. In the surplus lines market, premium tax payments are the unique and the sole responsibility of the broker who allocates and remits them to the state authorities. However, in some cases, a nonresident surplus lines broker cannot pay taxes to the states where portions of the multistate surplus lines risk lie, because the broker does not have, and cannot obtain, a non-resident surplus lines license (key points of the article on highlighted on pages 1 and 2).

Both McLeod and Fletcher disclose elements directed to doing business in the surplus lines market. Therefore, it would have been obvious to one of ordinary skill in the

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art at the time of Applicant's invention to include in the Internet Wholesale Insurance Exchange's (iwix.net) as disclosed of McLeod, the technique where surplus lines brokers can broker multistate risk that can include a state where the brokers are not licensed as disclosed by Fletcher, since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in that art would have recognized that the results of the combination were predictable. See MPEP 2143, Rational (A).

McLeod discloses that insurers registering on the site (i.e. iwix.net) will set guidelines for the types of business they're willing to consider, which allows iwix.net to point agents only to those underwriters able to provide quotations. *McLeod also teaches identifying insurers willing to write a particular risk* and agents will need to hold surplus lines licenses to access surplus lines insurers through iwix.net. (pg.2). However, McLeod does not explicitly teach the following limitations:

- identifying, by the server, at least one broker licensed in the jurisdiction that accepts submissions of the type transmitted by the insurance producer searching broker data in the database; and
- providing a database containing information sufficient to identify a plurality of brokers who are licensed in the jurisdiction to place surplus lines insurance policies of the type specified by the submission.

Ghosh teaches a system and method for managing licensing information in which a centralized database tracks all relevant information related to licensing of agents and agencies. The licensing information includes the states in which the agent is licensed and appointment information of the agent (e.g. insurance carriers, products authorized

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for sale by the carrier through the agent, etc.). Ghosh teaches that the licensing information system (LIS) can be accessed by compliance officers, insurance agents, agencies, carriers and *entities requiring insurance licensing and compliance services*. For instance, external systems may include sales systems which perform queries on the LIS to *verify whether certain agents may sell particular products in a given state* (§§0013-0014, §§0026 §§0030, §§0040-0041, §§0047-0048, §§0057 and Figs 3-4).

It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include the aforementioned limitations as taught by Ghosh within McLeod for the motivation to provide a centralized, updated and current, database that tracks all relevant information related to licensing of agents and agencies (§§0013).

As to claim 77, McLeod teaches the following limitations:

- wherein the surplus lines insurance policy includes a property and casualty insurance policy (pg.2; which discusses iwix.net, a virtual marketplace, that will let small and medium-sized agents place specialty property/casualty coverages with surplus lines insurers).

As to claim 80, McLeod teaches the following limitation:

- receiving by the server an acceptance of the quotation for the surplus lines insurance policy from the insurance producer (pg.2; which discusses an agent sending a request to bind coverage through iwix.net).

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7. **Claims 72-75** are rejected under 35 U.S.C. 103(a) as being unpatentable over McLeod, Fletcher and Ghosh as applied to claim 70 above, and further in view of Debber, Pub. No. 2003/0144887 (hereinafter “Debber”).

As to claims 72-75, neither McLeod, Fletcher nor Ghosh explicitly disclose the following limitations; however, Debber teaches the limitations:

- providing a graphical user interface to the insurance producer to allow the insurance producer to enter the applicant insurance data (Abstract, ¶¶0010, ¶¶0036-0039, ¶¶0052, ¶¶0066, ¶¶0092 and ¶¶0100-0106);
- wherein the graphical user interface allows the insurance producer to enter information related to an insured entity of the surplus lines insurance policy (Abstract, ¶¶0010, ¶¶0036-0039, ¶¶0052, ¶¶0066, ¶¶0092 and ¶¶0100-0106);
- wherein the graphical user interface is provided to the insurance producer over the internet (Abstract, ¶¶0010, ¶¶0036-0039, ¶¶0052, ¶¶0066, ¶¶0092 and ¶¶0100-0106); and
- wherein the graphical user interface is configured to be displayed by an internet browser (Abstract, ¶¶0010, ¶¶0036-0039, ¶¶0052, ¶¶0066, ¶¶0092 and ¶¶0100-0106).

It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include the aforementioned limitations as taught by Debber within the combination of McLeod, Fletcher and Ghosh for the motivation to provide a

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method for electronically creating, filing and approving applications for insurance coverage (§0010).

8. **Claim 79** is rejected under 35 U.S.C. 103(a) as being unpatentable over McLeod, Fletcher and Ghosh as applied to claim 70 above, and further in view of Luchs et al., Pat. No. 4,831,526 (hereinafter "Luchs").

As to claim 79, neither McLeod, Fletcher nor Ghosh explicitly disclose the following limitation; however, Luchs teaches the limitation:

- providing a database containing information describing legal requirements for placing surplus lines insurance policies of the type specified by the submission in the jurisdiction (Abstract, col.14, lines 35-45 and col. 21, lines 39-58; which discusses a central processor with a data bank containing the laws and regulations of various state agencies having governmental control over insurance transactions, such laws and regulations).

It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include the aforementioned limitations as taught by Luchs within the combination of McLeod, Fletcher and Ghosh for the motivation to provide a computerized insurance method for storing in a data bank information representing laws and regulations of individual state governments which control and regulate the various parameters of insurance contracts, in addition to look up tables which correlate information repeatedly called for on insurance policies (col.2, line 47 thru col. 3, line 4).

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9. Claims 81-84 are rejected under 35 U.S.C. 103(a) as being unpatentable over McLeod, Fletcher and Ghosh as applied to claims 70 and 80 above, and further in view of Jinks, Pub. No. 2002/0055862 (hereinafter “Jinks”).

As to claims 81-84, McLeod and Fletcher teach the element of the insurance policy being a “surplus lines insurance policy”; however, neither McLeod, Fletcher nor Ghosh explicitly disclose the following limitations; Jinks teaches the limitations:

- generating the surplus lines insurance policy according to regulatory requirements of the jurisdiction related to surplus lines insurance policies of the type specified by the submission (§0033; which discusses completing the processing of an insurance application and the issuance of an insurance policy, which includes additional information that is required by a particular state or regulatory agency);
- rating the surplus lines insurance policy based on a set of guidelines (§0015, §0025-0029 and §0039-0040; via underwriting rules and managing general agents (MGAs) providing a list of rules for each of the carriers that they represent);
- notifying an underwriter who underwrites the surplus lines insurance policy when the surplus lines insurance policy does not satisfy the set of guidelines (§0015, §0025-0029 and §0039-0040; which discusses risks that cannot be automatically assessed are routed an underwriter to evaluate the risk); and

- providing a graphical user interface to the underwriter to allow the underwriter to rate the surplus lines insurance policy when the insurance policy does not satisfy the set of guidelines (§0015, §0025-0029 and §0039-0040; which discusses underwriters accessing the system to provide manual input into the risk evaluation process for risks that cannot be evaluated automatically by the interactive insurance server).

It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include the aforementioned limitations as taught by Jinks within the combination of McLeod, Fletcher and Ghosh for the motivation to provide a method for obtaining commercial insurance quotations from a variety of insurance carriers (§0005).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to GREGORY JOHNSON whose telephone number is (571)272-2025. The examiner can normally be reached on Monday - Friday, 8:30AM - 5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, ALEXANDER KALINOWSKI can be reached on (571) 272-6771. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/GREGORY JOHNSON/
Examiner, Art Unit 3691